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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,083	03/22/2004	Peter J. Ashwood Smith	120-429	1381

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EXAMINER	
RYMAN, DANIEL J	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,083	ASHWOOD SMITH, PETER J.	
	Examiner	Art Unit	
	Daniel J. Ryman	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-12 and 14-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,3-12 and 14-28* is/are rejected.

7)☐ Claim(s) *1* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. While Applicant indicated that ref. 120 has been added to p. 13, line 11, no amendment to p. 13, line 11, was found in the Response filed 17 August 2006. As such, Examiner has maintained an objection to the drawings.

2. Applicant's arguments filed 17 August 2006 have been fully considered but they are not persuasive. On page 12 of the Response, Applicant asserts that, as amended, claims 1, 12, and 22 recite a different invention than that claimed in the '354 patent, and therefore statutory double patenting does not apply. Specifically, Applicant asserts that "claims 1, 12, and 22 could be infringed by a method using an indication of label availability not comprising a label list having one or more label identifiers." Examiner, respectfully, disagrees. The amended claims recite: a "label availability indication indicative of respective corresponding labels available for use by the source node." The '354 patent recites: a "label list having one or more label identifiers indicative of respective corresponding labels available for use by the source node." Examiner fails to see how a "label availability indication indicative of respective corresponding labels available for use by the source node" could be anything other than a "label list having one or more label identifiers indicative of respective corresponding labels available for use by the source node." Simply, how can something be "indicative of respective corresponding labels" other than by providing a "label list having one or more label identifiers"? While Examiner maintains that the claimed "label availability indication" has to be a "label list having one or more label identifiers" because "corresponding labels available for use by the source node" could not be indicated in any way other than through a "label list," Examiner recognizes that there may

be ways to perform this indication using something other than a "label list" that Examiner has not thought of. Therefore, Examiner has alternately rejected claims 1, 3-12, and 14-28 using statutory double patenting (assuming that the indication has to be a "label list") and nonstatutory double patenting (assuming that the indication does not have to be a "label list").

3. Examiner notes that even if it is assumed that the indication does not have to be a "label list," such that nonstatutory double patenting applies to the claims, statutory double patenting is still appropriate for claims 4-11, 15-21, 23, and 26-28 because these dependent claims narrow the independent claims to require that the "label availability indication" be a "label list." As such, with respect to these dependent claims, Applicant's rationale that "claims 1, 12, and 22 could be infringed by a method using an indication of label availability not comprising a label list having one or more label identifiers" does not apply since claims 1, 12, and 22, as modified by these dependant claims, requires that the "indication of label availability" be a "label list having one or more label identifiers." Therefore, claims 1, 12, and 22, as modified by these dependent claims, are drawn to the identical subject matter of claims 1, 11, and 20 in USPN 6,738,354.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: step 120 (see Fig. 3 and page 13, line 11). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 1 is objected to because of the following informalities: in lines 9-11, "destination node labels available for use" is confusing since it is unclear what the "labels available for use by each respective hop" are used to do. Appropriate correction is required.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1, 3-12, and 14-28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of prior U.S. Patent No. 6,738,354. This is a double patenting rejection. Although independent claims 1, 12 and 22 contain slightly different wording ("label availability indication indicative of respective corresponding labels available for use by the source node" and "the label switched traffic being associated with labels for use in switching the traffic between the source node and the destination node, each label identifying a respective data transport wavelength") than the wording contained in independent claims 1, 11, and 20 in USPN 6,738,354 ("label list having one or more label identifiers indicative of respective corresponding labels available for use by the source node" and "the label switched traffic made up of packets containing labels used to switch the packets between the source node and the destination node, each label comprising a respective data transport wavelength"), these claims, nonetheless, encompass the same subject matter.

8. Simply, a "label availability indication indicative of respective corresponding labels available for use by the source node" would necessarily be a "label list having one or more label identifiers indicative of respective corresponding labels available for use by the source node." Examiner fails to see how a node could indicate respective corresponding labels available for use by the source node without using a list having one or more label identifiers.

9. In addition, "the label switched traffic being associated with labels for use in switching the traffic between the source node and the destination node" and "the label switched traffic made up of packets containing labels used to switch the packets between the source node and the destination node" are equivalent since both limitations require that the label switched traffic have a label that is used to switch the packets. Further, "each label identifying a respective data transport wavelength" and "each label comprising a respective data transport wavelength" are equivalent since both limitations require that the label relate to a transport wavelength.

10. Thus, although the claim language is slightly different, claims 1, 12 and 22 disclose the same invention as independent claims 1, 11, and 20 in USPN 6,738,354, respectively. Additionally, claims 3-11 are equivalent to claims 2-10 in USPN 6,738,354, respectively; claims 14-21 are equivalent to claims 12-19 in USPN 6,738,354, respectively; claims 23-26 are equivalent to claims 21-24 in USPN 6,738,354, respectively; and claims 27 and 28, when read in conjunction with claims 1 and 12, respectively, are equivalent to claims 1 and 11 in USPN 6,738,354, respectively.

11. Alternatively:

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1, 3, 12, 14, 22, 24, and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 11, 12, 20, 22, and 23 of U.S. Patent No. 6,738,354, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "label availability indication" of claims 1, 3, 12, 14, 22, 24, and 25 is broader than the "label list" of USPN 6,738,354, such that "the label availability indication" covers things not covered by the "label list" of USPN 6,738,354. However, Examiner asserts that the "label list" of USPN 6,738,345 anticipates the "label availability indication" of claims 1, 3, 12, 14, 22, 24, and 25, as indicated by Applicant. See Response filed 8/17/2006: p. 12 (wherein "claims 1, 12, and 22 could be infringed by a method using an indication of label availability not comprising a label list having one or more label identifiers" indicates that a label list having one or more label identifiers is an indication of label availability). Given that the "label list" anticipates the "label availability indication," the above claims are obvious in view of USPN 6,738,354 since "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed.Cir. 1984). See

also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

14. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

15. Claims 4-11, 15-21, 23, and 26-28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3-10, 13-19, 21, 24, 1, and 11, respectively, of prior U.S. Patent No. 6,738,354. This is a double patenting rejection. Although claims 23 and 26-28 contain slightly different wording ("the label switched traffic being associated with labels for use in switching the traffic between the source node and the destination node, each label identifying a respective data transport wavelength") than the wording contained in independent claims 1, 11, and 20 in USPN 6,738,354 ("the label switched traffic made up of packets containing labels used to switch the packets between the source node and the destination node, each label comprising a respective data transport wavelength"), these claims, nonetheless, encompass the same subject matter. Simply, "the label switched traffic being associated with labels for use in switching the traffic between the source node and the destination node" and "the label switched traffic made up of packets containing labels used to switch the packets between the source node and the destination node" are equivalent since both limitations require that the label switched traffic have a label that is used to switch the packets. In addition, "each label identifying a respective data transport wavelength" and "each label comprising a respective data transport wavelength" are equivalent

since both limitations require that the label relate to a transport wavelength. Thus, although the claim language is slightly different, claims 23 and 26-28, as modifying claims 1, 12 and 22 disclose the same invention as independent claims 1, 11, and 20 in USPN 6,738,354, respectively. Examiner notes that by limiting the "label availability indication" of claims 1, 12, and 22 to a "label list" through dependent claims 23 and 26-28, Applicant has narrowed claims 1, 12, and 22 to be the same invention as claims 1, 11, and 20 in USPN 6,738,354. Additionally, claims 4-11 are equivalent to claims 3-10 in USPN 6,738,354, respectively, and claims 15-21 are equivalent to claims 13-19 in USPN 6,738,354, respectively.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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